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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,273	07/29/2003	Osami Kaneto	566.42987X00	4716
20457	7590	10/04/2005	EXAMINER	RODRIGUEZ, PAUL L
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			ART UNIT	PAPER NUMBER
2125				
DATE MAILED: 10/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/628,273	KANETO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul L. Rodriguez	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 9 is/are rejected.
- 7) Claim(s) 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

1. The amendment filed 8/4/05 has been received and considered. Claims 1-5, 8 and 9 are presented for examination.

### ***Claim Objections***

2. Claims 8 and 9 are objected to because of the following informalities:

Claim 8 line 14 recites, "...indicated by by using..."

Claim 9 line 5, equation 1 ends with " $(1-A(t))^n$ ", that same equation in the specification is indicated by " $(1-A(t))^N$ ". Also, the variables recited on claim 9 line 12 refer to "N", not "n".

Claim 9 line 5, equation 5 ends with " $(1-A(t))^n$ ", that same equation in the specification is indicated by " $(1-A(t))^N$ ". Also, the variables recited on claim 9 line 12 refer to "N", not "n".

Claim 9 line 15 refers to "...from equations 6-7 given below...", lines 16-18 of the claim list equations 6-8.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims recite limitations that are directed to both an apparatus and a method. Because of this, the claims are considered to embrace or overlap two

different statutory classes of invention set forth in 35 U.S.C. 101, therefore they are held to be directed to neither a "process" nor a "machine".

***PRODUCT AND PROCESS IN THE SAME CLAIM***

*A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.*

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims. 1-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

***Allowable Subject Matter***

5. Claim 8 is allowed over the prior art of record for the reasons presented in the amendment and remarks presented in the amendment filed 8/4/05. Minor objection to the claim remains.

***Response to Arguments***

6. Applicant's arguments, filed 8/4/05, with respect to the rejection(s) of claim(s) 1-8 under 35 U.S.C. §103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. §101 and 35 U.S.C. § 112.

Regarding the drawing/specification objections, the amendment to the specification corrected the deficiencies and the objections are withdrawn.

Regarding the objection to the abstract, the amendment to the abstract removed the deficiencies and the objections are withdrawn.

Regarding the rejection under 35 U.S.C. §101, while applicant has overcome the previous rejections, upon further review of the current claim language, the claims are held non-statutory due to the claiming of both an apparatus and a method and have been rejected based upon guidance set forth in the MPEP, see above.

Regarding the rejection under 35 U.S.C. §103. Due to the amendments to the claims and remarks made, the rejections are withdrawn.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kolavennu et al (U.S. Pat 6,856,856) – teaches a method of simulating a mold design to determine possible disturbances in a mold during system operation, and the generation of a corrective action control upon detection of the disturbance.

Harada et al (U.S. Pub 2005/0179158 and 2005/0181085) – teach a mold system that performs flow analysis to ensure product strength.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L. Rodriguez whose telephone number is (571) 272-3753. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul L Rodriguez  
Primary Examiner  
Art Unit 2125

PLR  
9/30/05